

REMARKS/ARGUMENTS

The office action of July 14, 2005 has been reviewed and these remarks are responsive thereto. Claims 2-52 and 54-60 are pending in this application.

Interview Summary

Applicants thank Examiner Tran and SPE Corsaro for meeting with Applicants' representative on September 21, 2005. During the interview, we discussed U.S. patent no. 5,991,737 to Chen (Chen) and outstanding rejections to claims 2-52 and 54-60 based thereon. We also discussed the lack of a *prima facie* case of obviousness for these claims in the outstanding office action based on Chen.

As agreed to in the interview and discussed further below, Applicants respectfully request reconsideration and withdrawal of the outstanding final office action.

*Lack of *prima facie* case of obviousness – the claimed call server exits the connection*

Claims 2-52 and 54-60 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,991,737 to Chen (Chen). Reconsideration and allowance of the instant application are respectfully requested.

As discussed in the interview, the office action fails to make a *prima facie* case of obviousness for rejecting the pending claims, at least because Chen discloses a product ordering system that relies upon a processing station 22 acting as an *intermediary to enable all interactions* between a consumer 24 and a media content originator 12. Through its role as intermediary, “processing station 22 in effect enables direct and indirect wireless or wired interaction between media content originator 12 and consumer 24.” Chen, col. 4, lines 30-32. It does so ‘in effect,’ rather than in actuality, due to its role as intermediary for those interactions.

Modifying the Chen system as proposed in the office action to remove the processing station from interactions between the consumer and the media content originator after communication is established therebetween would destroy the intended functionality of Chen and would render the Chen system inoperable. For at least this reason, the office action fails to make a *prima facie* case of obviousness for rejecting claims 2-52 and 54-60.

In particular, the processing station of Chen necessarily remains involved in any interactions it establishes ‘in effect’ between the media content originator and the consumer device. As illustrated in Fig. 1, interactions between the media content originator of Chen and the consumer occur either completely indirectly *via the processing station*, or they are controlled by *the processing station* when the media content originator sends a product directly to a consumer or indirectly through a retail source. Either way, the processing station *remains involved* in the interactions.

As shown in Fig. 2, the order processor 36 of the processing station acts as an intermediary between the media content originator and the consumer when processing consumer orders. As shown further therein, the fulfillment processor 38 of the processing station interacts with the consumer when fulfilling orders, rather than with the media content originator interacting with the consumer, even though fulfillment of the orders may be outsourced as described in col. 5, lines 19-22 and col. 4, lines 26-29. Thus, the system of Chen relies upon the processing station *at all process ordering stages* to act as an intermediary to enable the interactions between the consumer and the media content originator.

It is well-grounded that a proposed modification would not have been obvious if it destroys its intended function. *See e.g., In Re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). Further, it is equally well grounded that the mere possibility that the prior art could be so modified does not make the modification obvious “unless the prior art suggested the desirability of such a modification.” *In re Brouwer*, 77 F.3d 422 (Fed. Cir. 1996). The outstanding office action is unable to show a motivation for modifying Chen as it proposes and it fails to show how the Chen system could function with its processing station removed from a connection between the consumer and the media content originator. The office action relies upon its proposed modification to Chen to reject all of claims 2-52 and 54-60 as allegedly being obvious. Thus, the outstanding office action fails to make a *prima facie* case of obviousness for rejecting claims 2-52 and 54-60 and should, therefore, be withdrawn.

In contrast with Chen, independent claim 2 recites a call server that performs the step of exiting from a two-way wireless connection between the device associated with the broadcast program and the mobile device. Further, independent claim 45 recites a method that includes

the step exiting from an interactive connection between a device associated with a host and a mobile terminal. Similarly, independent claims 9, 16, 24, 33 and 45 recite the subject matter of maintaining a two-way connection, a two-way wireless connection, an interactive connection or a voice connection between a first device and a second device without a call server being involved in the maintained connection. Thus, the recited two-way, interactive or voice connections of these claims are independent connections between the respective entities that do not need to be maintained by a call server.

For at least these reasons, Chen does not teach or suggest the recited subject matter of independent claims 2, 9, 16, 24, 33 and 45 or the subject matter of claims 3-8, 10-15, 17-23, 25-32, 34-44, 46-52 or 54-60 depending therefrom. Accordingly, Applicants respectfully submit that claims 2-52 and 54-60 are allowable over Chen.

Lack of prima facie case of obviousness – the claimed two-way, voice or interactive connection

In addition to the reasons stated above, Applicants respectfully submit that independent claims 2, 9, 16, 24, 33 and 45 are allowable over Chen because each of these claims recite the subject matter of establishing a two-way connection, a two-way wireless connection, a voice connection, or an interactive connection between a first device or terminal and a second device or party, which are not taught or suggested by Chen. Although the office action proposes a modification to Chen to allegedly provide these recited connections, the proposed modification is not obvious and there is no reasonable expectation of success to modify the one-way, product ordering system of Chen according to the proposal.

In particular, the office action admits that Chen “does not explicitly mention that the request [is] made by the mobile device specifying for an interactive (two-way voice or data) wireless connection” (page 3) and the steps of sending and receiving connection requests. The premise of the office action to support its obviousness conclusions is that the processing station of Chen “*decides whether or not to establish the direct wireless interaction* between the [consumer] 24 and the device associated with the broadcast program 12, 14.” Emphasis added. Office action, page 3. This is an incorrect characterization of Chen and is a flawed lynchpin of the obviousness argument. The office action continues that it would have obvious to permit a

user to specify the type of connection in the request, such as a two-way connection, for the advantage of user friendliness. However, there is no connection request in Chen at all, and a modification to the product ordering request actually disclosed in Chen to provide the recited connections is unreasonable for the Chen system and certainly would not have been obvious.

The lynchpin premise of the office action is flawed, at least because Chen does not teach or suggest *any decisions* regarding the type of interactions between the consumer and the media content originator, much less decisions for two-way, voice or interactive connections or requests for these connections. The office action points to col. 4, lines 18-33 to support its basic premise that the Chen system discloses a decision whether to establish a direct wireless interaction. However, this portion of Chen merely discloses decisions at the processing station regarding the processing of orders, not the type of connection or whether to establish it. According to this portion of Chen, the processing station may decide to “initiat[e] action desired by the consumer (such as the purchase of a product)” (col. 4, lines 20-21), to provide “feedback, an acknowledgement or a request for additional information (such as an account number)” (*id.* at lines 22-23), to fulfill an order (*id.* at lines 24-25), or to communicate with the media content originator to have the order fulfilled (*id.* at lines 26-29).

These actions in Chen are basic order processing actions that are unrelated to a type of connection between the consumer and the media content originator or whether to establish a connection. Thus, Chen does not disclose or suggest processing decisions related to the type of connection between the consumer and the media content originator, much less requests to establish two way, voice or interactive connections. As such, Chen does not disclose the decision asserted in the office action of “whether or not to establish the direct wireless interaction” or the recited two way, voice or interactive connections of claims 2, 9, 16, 24, 33 and 45.

Further, there is no reasonable expectation of success that a processing decision for a two-way interaction request between the media content facilitator and the consumer, if permitted, could be supported by the system of Chen. There is no suggestion that the media content originator could interact with consumers beyond sending requested products if instructed to do so by the processing station. Further, it is unreasonable to assume that the media content

originator could do so, as the processing station is established as an intermediary for interacting with consumers in an automated manner that does not burden the media content originator. Thus, a consumer request for a direct interaction with the media content originator would likely be dismissed by the processing station. The only disclosed interaction between the media content facilitator and the consumer in Chen is a one-way, order-fulfillment, shipping relationship from the media content originator to the consumer. It is unreasonable to expect that such a system could be successfully modified to provide the direct wireless interaction proposed in the Office Action or the recited two-way, voice or interactive connection of claims 2, 9, 16, 24, 33 and 45.

Because the system of Chen does not make connection decisions or decide whether to establish a direct wireless interaction as asserted in the office action, the proposed modification of Chen would not have been obvious. In addition, there is no reasonable expectation of success to modify the one-way, product ordering system of Chen according to the proposal to provide the recited two-way, voice or interactive connections of these independent claims. For these additional reasons, Applicants respectfully submit that independent claims 2, 9, 16, 24, 33 and 45, and claims 3-8, 10-15, 17-23, 25-32, 34-52 and 54-60 depending therefrom, are allowable over Chen.

Appln. No.: 10/015,780
Reply dated October 12, 2005
Reply to office action of July 14, 2005

Based on the foregoing, Applicants respectfully submit that the application is in condition for allowance and a Notice to that effect is earnestly solicited. Should the Examiner believe that anything further is desirable in order to place the application in even better form for allowance, the Examiner is respectfully urged to contact Applicants' undersigned representative at the below-listed number.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated: October 12, 2005

By:



Anthony W. Kandare,
Registration No. 48.830

1001 G Street, N.W.
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001